FOR ARGUMENT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-642

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS,

Petitioner,

v.

DALE R. FLOOK

Respondent.

BRIEF AMICI CURIAE FOR AMERICAN PATENT LAW ASSOCIATION AND LOS ANGELES PATENT LAW ASSOCIATION

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CHANGES IN BRIEF

Page 10, paragraph 6, line 4, the sentence "By the same token, a novel and useful process within the contemplation of 35 U.S.C. 101 can be so created." is not part of the quote and should be incorporated into the main text.

Page 14, line 3, the word "unobvioius" should be "unobvious"; line 7, the word "has" should be "have".

Page 16, in the first full paragraph, line 6, "invalid" should be "valid".

Page 17, first full paragraph, line 2, delete "mathe-".

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I.

INTEREST OF AMICI

This brief Amicus Curiae is submitted jointly by the American Patent Law Association ("APLA") and the Los Angeles Patent Law Association ("LAPLA") under Rule 42(2) of this Court. The consent of the parties' counsel has been obtained to the filing of this brief and will be separately filed with the Court.

APLA is a nationwide Association of approximately 4,000 members including Judges, Law Teachers, Copyright

and Trademark Lawyers, and approximately half the Patent Lawyers in the country, from private, corporate, and government practice. LAPLA is similarly constituted and has approximately 400 members.

Unlike some specialties of law practice where the plaintiffs and defendants are often represented by predominantly separate legal fraternities, in patent law the same individual attorneys may appear as often on the plaintiff's side as on the defendant's side of patent, trademark and copyright litigation, and on either the licensor's or licensee's side of negotiations for licenses. By such experience and membership composition, these Associations are well balanced in the realities of the patent law in action.

These Associations appear here in an attempt to assist the Court and in an effort to assure orderly development of the patent law. More particularly, the amici Associations appear because they are deeply concerned that Petitioner's brief badly confuses and erroneously intermingles two separate and distinct principles of patent law which are:

(1) the law relating to the *types* of subject matter which may be patented under any circumstances (as prescribed in 35 U.S.C. 101); and

(2) the *requirements* for patentability of subject matter which *is* of the type which may be patented (as prescribed in 35 U.S.C. 102 and 103).

Furthermore, the amici Associations believe that a *single* standard of patentability should apply to patent claims, not, as Petitioner's brief would have it, a different standard of patentability for patent claims containing algorithms as compared with all other types of claims.

II.

THE SOLE ISSUE BEFORE THIS COURT IS WHETHER THE FLOOK CLAIMS RECITE A "PROCESS" WITHIN THE MEANING OF 35 U.S.C. 101, NOT WHETHER THAT PROCESS IS PATENTABLE OVER THE PRIOR ART UNDER 35 U.S.C. 102 OR 103.

The sole issue presented in this case is whether the claims of the patent application filed by respondent Flook recite a "process" within the meaning of 35 U.S.C. 101, which provides that patents may be granted to:

> "Whoever invents or discovers any new and useful process. . . ."

It is of utmost importance to take note of the fact that the record in this case establishes that patentability over the prior art is *not* an issue which has been ripened for decision by this Court because:

(1) the final rejection by the Patent Examiner (App. 25 A-27 A) did not reject the claims as unpatentable over the prior art;

(2) the decision by the Board of Appeals of the Patent and Trademark Office (App. 52 A-55 A) did not reject the claims as unpatentable over the prior art; and

(3) the decision of the Court of Customs and Patent Appeals in this case, *In re Flook*, 559 F.2d 21 (1977), did not reject the claims as unpatentable over the prior art.

Rather, both the Patent Examiner and the Board of Appeals of the Patent and Trademark Office rejected the claims as failing to recite a "process" within the meaning of 35 U.S.C. 101 which could be patented. Both the Patent Examiner and

the Board of Appeals of the Patent and Trademark Office concluded that the claims were drawn not to a process but to an algorithm and that a "patent containing these claims could in effect be a patent on the algorithm itself." (App. 53 A.)

Furthermore, the Patent Examiner conceded (App. 47 A) that the claimed process "is a technologically useful invention." The invention comprises a method for adjusting the "alarm limit" of at least one process variable in a process comprising the catalytic chemical conversion of hydrocarbons. The claimed method is described with adequate specificity at pages 3-5 of Petitioner's brief. For the purposes of deciding the sole issue before this Court, it is believed to be sufficient to note that each of the claims here involved includes the following steps (App. 63 A, 64 A):

(a) "determining the present value of said process variable";

(b) using algorithms to determine an updated alarm limit; and

(c) "adjusting said alarm limit to said updated alarm limit value."

In specific terms, the question which has been brought before this Court is whether the foregoing process steps constitute, as this Court viewed the claims for converting one type of number to another in *Gottschalk v. Benson*, 409 U.S. 63 (1972), an abstract principle which cannot be patented, on the *application* of a principle to a *useful* end, which *Benson* made clear *can* be patented.

III.

SUMMARY OF ARGUMENT

The patent application claims before this Court recite *use* of an algorithm to determine the alarm limit value for a process variable in a hydrocarbon conversion process *and* the *adjusting* of the alarm limit to the updated value so determined. As such, the claims recite a *post-solution* step which takes the use of the algorithm out of the abstract and makes it concrete and tangible, thereby supplying the post-solution activity which was lacking in *Gottschalk v. Benson*, 409 U.S. 63 (1972).

Petitioner's contention that a process which employs a mathematical or scientific principle must be inventive in both conception and implementation, viz., that it must be doubly inventive, is totally at odds with 35 U.S.C. 103 and the leading Supreme Court case on the subject, *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The claims before this Court are directed to a concrete technological process, not an idea, and are statutorily proper under 35 U.S.C. 101. Petitioner's attempt to transmute this statutorily proper process claim into a non-statutory "idea" claim by focusing only on the algorithm recited is simply an incorrect analysis and is incompatible with this Court's holding in *MacKay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U.S. 86, 94 (1939).

This Court's holding in *Gottschalk v. Benson, supra*, is not only fully consistent with *MacKay* but supports the view that the Flook claims are statutory because they apply a principle to a useful end, a factor that was absent from the *Benson* claims.

Petitioner's brief is directed not to an issue before this Court (whether the claims recite a statutory process) but to an issue not properly before this Court (patentability over the prior art). Given the limited record before this Court on the issue of patentability, if Petitioner has belatedly concluded that patentability over the prior art is an important issue in this case, it should seek remand, not reversal.

Petitioner's contention that an inventor's own conception should be used as prior art against him and, even if the conception is unobvious, the implementation of that conception must *also* be inventive for patentability to exist, represents a serious distortion of the prior holdings of this Court and other courts and involves an improper departure from the standards of patentability prescribed in *Graham*.

IV.

ARGUMENT

A. The Flook claims include a post-solution step which takes the use of the algorithm out of the abstract and makes it concrete and tangible, thereby supplying the post-solution activity lacking in Gottschalk v. Benson.

This is, in effect, the *post-solution* step which takes the use of the algorithm out of the abstract and makes it concrete and tangible, thereby supplying the post-solution activity which was lacking in *Gottschalk v. Benson*, 409 U.S. 63 (1977).

The patent application claims before this Court recite the *use* of an algorithm to determine the alarm limit value for a process variable in a hydrocarbon conversion process *and* the *adjusting* of the alarm limit to the updated value so

determined. As such, the claims recite, in the words of *Cochrane v. Deener*, 94 U.S. 780, 788:

> ". . . a series of acts, performed upon the subject matter to be transformed and reduced to a different state. . . ."

In other words, the adjusting of the alarm limit from its original value to its updated value is an act performed to accomplish the transformation of the alarm limit from an original state to a different state. Accordingly, it is clear that the claims recite a statutory process within the meaning of 35 U.S.C. 101.[1]

Indeed, Petitioner's brief is riddled with concessions that the claims in issue recite a statutory process, e.g., the very commencement of Petitioner's argument (Pet. Br. 9) states that:

> "The only *advance over the prior art* contained in *Respondent's method* is the mathematical algorithm *it utilizes.*" (Emphasis added.)

This is not a statement that the claim is directed to the algorithm itself; rather, it is the first step in the remainder of Petitioner's argument which is, in reality, simply an argument that the algorithm does not patentably distinguish the claimed method from the prior art, *not* that the claimed method is nothing more than an algorithm which could not be patented under 35 U.S.C. 101. In fact, it is because Petitioner has chosen to argue a question not properly before this Court, viz., patentability over the prior art, but has

[1]It should be noted that it is not necessary that the claimed process be of the *Cochrane v. Deener* type for this Court to hold that it is statutory. For contrary to Petitioner's contention (Pet. Br. 12-16), this Court in *Benson* held that to be patentable, statutory processes need not necessarily operate to transform an article to a different state or be tied to the operation of a specific apparatus. 409 U.S. at 71.

couched this argument in terms of whether the process is statutory under Section 101 (rather than making the appropriate patentability analysis prescribed by Sections 102 and 103 and *Graham v. John Deere Co.*, 383 U.S. 1 (1966)) that the amici Associations have a grave concern that serious confusion and potential distortion of the fabric of the patent law could result.

B. Petitioner's contention that a process which employs a mathematic or scientific principle must be inventive in both conception and implementation is totally at odds with 35 U.S.C. 103 and Graham.

In this regard, Petitioner, straying far afield from the question of statutory subject matter under Section 101, devotes considerable attention (Pet. Br. 19-23) to an argument that is in direct conflict with this Court's holding in *Graham*, i.e., Petitioner argues that, in order to be patentable, a process which employs a mathematical or scientific principle must be inventive in its implementation as well as in its conception. That is to say, Petitioner argues that, in order to be patentable, an invention must be doubly inventive such that even if the concept of applying a particular scientific or mathematical principle in a certain process or machine is unobvious, the *manner* in which that concept is *implemented* must *also* be unobvious in order for the process or machine to be patentable. Such a theory is totally at odds with the relevant statutory prescription, 35 U.S.C. 103, and the leading case, *Graham*, which interprets that statute.[2]

[2]We will refer to this point hereafter.

C. The claims are directed to a concrete technological process, not an idea, and are statutorily proper under 35 U.S.C. 101.

As we have pointed out above, the process claims here involved contain a series of steps including the solution of an algorithm and culminating in the *post-solution* step of "adjusting" the alarm limit of the process variable to a new updated value. Thus, it is clear that these claims recite the transformation of the state of the alarm limit from an original state to a new and different state. As such, there can be no doubt that these claims are directed to a "process" as that term is used in 35 U.S.C. 101 and according to the ordinary usage of that term.

Petitioner attempts to transmute this statutorily proper process claim into a non-statutory "idea" focusing only on the algorithm recited in the claim and, in effect, arguing that a claim which recites a statutory process can be rendered non-statutory by adding to that claim the recitation of an algorithm. This is simply an incorrect analysis.

Manifestly, patent claims must be read as a whole and cannot be dissected for the purpose of determining whether they recite statutory subject matter any more than they can be dissected for purposes of determining infringement[3] or patentability over the prior art.

[3]See *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961) where this Court held that there is no legally recognizable *part* of a claim which can be considered the essential element, gist or heart of a patent claim. Rather, a claim must be read as a whole for the purposes of determining infringement and the same approach is the only one which can properly be taken here.

This principle was cogently articulated in *In re Chatfield,* 545 F.2d 251, 158 (C.C.P.A. 1976) where the court said:

> "Our reference in *Christensen* to the mathematical equation as being 'at the point of novelty' *does not equate* to a holding that a claim may be dissected, the claim components searched in the prior art, and, if the *only component* found novel is outside the statutory classes of invention, the claim may be rejected under 35 U.S.C. 101. That procedure is *neither correct nor within the intent of Congress* for the reasons we stated in *Bernhart* (427 F.2d 1365)." (Emphasis added.)

To do otherwise would be to fall into the error pointed out by Mr. Justice Holmes in *Joseph Schlitz Co. v. Houston Ice and Brewing Co.*, 250 U.S. 28 (1919), when he said:

> "It is a fallacy to break the fagot stick by stick."

Were this not the case, this Court's decision in *MacKay Radio & Telegraph Co. v. Radio Corporation of America,* 306 U.S. 86, 94 (1939) would have been drastically different. There, this Court held that claims to a radio antenna which differed from the prior art only by reason of recitation of a mathematical formula which expressed the angle between each wire of the antenna and its bisector was a structure eligible for patentability under the patent laws. In *MacKay*, the Court noted that:

> ". . . (W)hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be." 306 U.S. at 94. By the same token, a novel and useful process within the contemplation of 35 U.S.C. 101 can be so created.

Thus, we believe it fair to say that it will be necessary for this Court to overrule *MacKay* if it is to adopt Petitioner's

position in the present case that the process claims here involved do not recite a statutory process.

D. This Court's holding in Gottschalk v. Benson supports the Amici view that the Flook claims are statutory because they apply a principle to a useful end.

The decision in *Gottschalk v. Benson,* 409 U.S. 63 (1972) is in no way inconsistent with *MacKay* or *Chatfield.* The claims before this Court in *Benson* were *not* directed to a process for transforming a concrete device (here, an alarm limit) from an original state to a new state, but rather to a method for converting a certain type of *number,* binary coded decimal numerals, into another kind of number, pure binary numerals. Thus, the claims in *Benson* were directed to a *mathematical* manipulation of precisely the same character as the conversion of fractions to decimals by dividing the numerator of a fraction by its denominator. Plainly, a number conversion, such as that involved in *Benson*, or the conversion of fractions to decimals, is an abstract principle which *Benson* held is not patentable subject matter under 35 U.S.C. 101.

However, it can be of no assistance to this Court to argue, as Petitioner does, that simply because a part of the claims in the present case constitutes a mathematical algorithm, those claims do not constitute statutory subject matter. Such an argument improperly fails to treat the claims as a whole, as required by 35 U.S.C. 103.[4]

[4]Section 103 talks in terms of whether "the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (Emphasis added.)

If anything, the decision in *Benson* supports the view that the claims in the present case do, in fact, recite statutory subject matter because what was found lacking in *Benson*, the *application* of the principle to a *useful end*, is present here.

E. The issue of patentability over the prior art is not properly before this Court.

Read as a whole, it is believed that Petitioner's brief is not, in reality, directed to the issue nominally before this Court (whether the claims recite a statutory process), but is directed to an issue not properly before this Court, namely, patentability over the prior art. The amici Associations express no view on the issue of patentability over the prior art because they believe that that issue cannot be properly decided upon the record in this case and, indeed, has not been developed by the administrative process below. At present, there is really no prior art before the Court, only Petitioner's assertions with regard to bits and pieces of the claimed process which Respondent has allegedly conceded to be in the prior art. However, even if the concessions are as represented, Respondent has had no occasion to, and therefore no opportunity to, put into the record such evidence as might be available to him to demonstrate that his claims are unobvious over the prior art within the meaning of 35 U.S.C. 103 and in the manner prescribed by *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Furthermore, the "Appendix" attached to Petitioner's Brief makes extensive reference to extra-record matters such as the Brown Publication cited in footnote 2 at page 3A. This is tantamount to starting the patent examining process in this Court rather

than seeking remand for further examination by the Patent Examiner in light of this reference.

It is wholly inappropriate for Petitioner to attempt to short-circuit the administrative process by urging this Court to consider patentability over the prior art on the basis of the limited record before it. If Petitioner has belatedly concluded that patentability over the prior art is an important issue in this case, it should seek remand, not reversal.

Petitioner's brief urges upon this Court an erroneous and improper standard of patentability and, because the amici Associations are deeply concerned that the patent law would be seriously distorted if that erroneous standard rather than the standard prescribed by *Graham, supra,* were adopted, we believe a discussion of standards of patentability to be imperative, even though we also believe that patentability over the prior art is not properly before this Court.

F. Petitioner urges an improper departure from the standards of patentability prescribed in Graham.

In *Graham, supra,* this Court held that the standard of patentability (or invention) was constitutional and was to be decided by first determining the scope and content of the prior art, the level of skill in the art and the differences between the prior art and the claimed invention, and then determining whether such differences would have been obvious to one of ordinary skill in the art at the time the invention was made.

In a serious distortion of the prior holdings of this Court and other courts, Petitioner urges (Pet. Br. 19-23) that an entirely different standard of patentability should be used.

According to Petitioner, an inventor's own conception should be used as prior art against him and, even if the conception is unobvioius, it is argued that the implementation of that conception (or "idea") must *also* be "inventive," i.e., unobvious, in order for patentability to exist. Patentability should not be, and has not been, judged by such a four-foot yardstick. The courts and Congress has been consistent in recognition of the fact that the hurdle of inventiveness, i.e., unobviousness, must be cleared only once in order to obtain a patent.

A few examples will suffice. Charles Goodyear's conception or "idea" that rubber could be effectively vulcanized by adding sulphur to a mass of molten rubber is generally recognized as a significant contribution to mankind and was patented. Yet, the *implementation* of that idea amounted to nothing more than adding sulphur to rubber and, plainly, was not separately inventive. Similarly, the conception, or "idea," of Wallace H. Carrothers that certain chemicals could be reacted to produce a useful plastic material (nylon) was implemented by placing those chemicals in a suitable container, e.g., a beaker, and allowing them to react. Given the idea, the implementation was straightforward and not inventive. The same would be true of most chemical reactions. Yet, a patent was granted to Carrothers and hundreds of thousands of other chemical reactions have been patented. Another famous invention, which was found by this Court to be the subject of a valid patent in *Eibel Process Co. v. Paper Co.*, 261 U.S. 45 (1923), and which involved the tilting of a known paper-making machine (the "Fourdrinier"), was clearly unobvious only in conception, not in its implementation.

Still further, 35 U.S.C. 100(b) expressly provides that a new use of a known machine, process or composition is

patentable as a process. Given the conception or "idea" of making such a new use of a known machine, process or composition, Section 100(b) would be meaningless if there was an *additional* requirement that the implementation of the idea also be inventive, i.e., unobvious It is not surprising, therefore, that many patents have been issued for the new use of existing compositions as processes, e.g., methods of treating diseases by administering the composition, which involved a manifestly noninventive implementation, i.e., having the patient ingest the medicine. Thus, several centuries of uniform judicial and administrative precedent have required *only* that the "idea" be inventive, i.e., unobvious in order to be patentable.

It follows that if the idea or discovery is reduced to tangible form, and if it is unobvious, it is a patentable invention and there is absolutely no basis for the assertion that the implementation of the unobvious idea must *also* be unobvious. But the Petitioner urges that an additional requirement that the implementation of the idea also be inventive, i.e., unobvious, will safeguard "the free exchange of abstract intellectual concepts, which are 'the basic tools of scientific and technological work' (*Gottschalk v. Benson*, 409 U.S. 63, 67)" (Pet. Br. 10). It has never been seriously urged, however, that abstract intellectual concepts and disembodied ideas should be preemptable by patent. Indeed, it was the disembodied nature of the claimed mathematical principles in *Benson* that led this Court to conclude that the claims there presented "were not limited to any particular art or technology, to any particular apparatus or machine or to any particular end use." Obviously, claims so disembodied and unlimited could do little else than appear to preempt an underlying algorithm. If Petitioner's proposition is accepted

that it is only the "inventive use" of a new principle that warrants patent protection, then this Court's holding that Eibel's contribution "that surprised and startled the paper-making trade" (261 U.S. 45, 55) was improperly decided because all that Eibel did to implement his discovery was to elevate the "well known and universally used" Fourdrinier machine to some slight angle with the horizontal. Would Petitioner suggest that the grant of the patent to Eibel precluded the "free exchange of abstract intellectual concepts" in Eibel's discovery involving the unobvious application of a physical principle, viz., the force of gravity?

If as Petitioner would have it, an inventor's idea is, in effect, used as prior art against him, the result is a hindsight approach to the issue of patentability which this Court has many times condemned, most recently in *United States v. Adams*, 383 U.S. 39, 50 (1966), where, in the course of determining that a patent directed to a battery was invalid, this Court ruled that it "begs the question" to state that the battery components claimed in combination were known to have been used individually as such components in other batteries. Rather, this Court pointed out that the issue was whether "bringing them together" was patentable. However, given the idea of bringing them together, the implementation of that idea could not be said to be unobvious since it involved nothing more than putting the components together in a conventional manner to construct a battery.

While Petitioner contends that there is language in *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948), which can be read to express a different standard of patentability (Pet. Br. 19-20), such a contention necessarily involves a reading of *Funk* in a manner inconsistent with

Graham, Adams and the 1952 Patent Act.[5] More specifically *Funk* involved product claims directed to a mixture of naturally occurring bacteria. This Court held that such naturally occurring bacteria are, by definition, in the prior art and that packaging them as a mixture could not amount to invention because the mixture was intended to do in concert what the individual bacteria would do separately. This Court further held that the concept, i.e., the choice of mutually non-inhibitive strains of bacteria, was not inventive because it was a "simple step", i.e., obvious, to mix those strains which would not have an adverse effect on each other. This is a far cry from Petitioner's theory, which would apply a different standard of patentability, not in conformance with *Graham's* interpretation of Section 103, requiring unobviousness of implementation even if the concept was unobvious.

Contrary to Petitioner's theory, the standards of *Graham* necessarily apply to inventions involving the use of mathe-mathematical or scientific principles in the same manner as they do to other types of inventions.

V.

CONCLUSION

The law, as it relates to the patentability of claims containing mathematical algorithms, has been developing in a logical and orderly manner since this Court's decision in

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[5] *See also, Blonder-Tongue Laboratories v. University of Illinois Foundation*, 402 U.S. 313, 333 (1971), requiring use of the *Graham* standards.

Gottschalk v. Benson, 409 U.S. 63 (1972). The Court of Customs and Patent Appeals has followed the prescription of *Benson* in refusing to allow claims which recited no post-solution application of the algorithm in *In re Christensen*, 478 F.2d 1392 (C.C.P.A. 1973) because such claims did not recite statutory subject matter, but has, consistent with *MacKay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86 (1939) and the discussion of *MacKay* in *Benson*, found that claims which recite post-solution steps which apply the solution in a tangible and concrete manner to comprise statutory subject matter in *In re Chatfield*, 545 F.2d 152 (C.C.P.A. 1976) and in the present case. Thus, we believe that the decision of the court below that the claims here involved recite statutory subject matter should be affirmed.

We also believe that the issue of patentability over the prior art is not properly before this Court and should not be decided upon the record here.

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